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EXAMINER

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ART UNIT

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 09/532,968
Filing Date: March 22, 2000
Appellant(s): JOLLY ET AL.

MAILED

SEP 23 2002

Raja Saliba
For Appellant

GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 August 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Art Unit: 1731

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because (1) it fails to summarize what steps are actually required by the independent claim. It essentially only discusses the disclosed invention and some (unclaimed) end results. And (2) it fails to completely summarize the "one-ended reduction in length".

The statement that "Appellant's method requires a reduction in the number of layers over the recited length" is incorrect. This is an unclaimed limitation.

(Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).)

The claims make no mention of any number of layers in the final product. The claims are comprising in nature and thus are open to having an equal number of layers deposited - for instance by another torch - or by the same torch in a subsequent step.

Also, the statement that the preform has "a reduced diameter portion" is also not required by the independent claim. Although that is a disclosed feature, it simply is not required by the claim.

(Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).)

Art Unit: 1731

The discussion regarding the one-ended reduction in length is in error. It is stated that page 8, lines 3-10 of the specification describe the one-ended reduction in length. That portion of the specification merely states how the reduction is "imposed" and how it is "performed"; it does not describe what that reduction actually is. Claim 1 at lines 12-13 requires, "said method interposing a one-ended reduction in length". As can be seen from instant figure 3, when torch 5 cuts the layers, there is a reduction in length of the layers. This occurs at one end - thus the one-ended reduction in length. It is noted that body 1' is comprises numerous layers that are not shown.

The summary also fails to discuss the "reduction in the lengths of the displacements"; claim 1, line 17. As per figure 2, this reduction causes the conical ends of the preform. This reduction is essentially two-ended, because both ends of the displacements are less than the previous displacements.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-8 stand or fall together as Appellant indicates.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the invention of claim 1: namely the last two lines of the claim: "wherein the one ended reduction in the length is greater than a reduction in length of an immediate prior layer from a second to the immediate prior layer."

First, Examiner could not find explicit support for this limitation. Second, Examiner could not find any implicit support for this limitation. Third, the drawings suggests the OPPOSITE of this limitation: the reduction is less - not greater.

Looking at instant figure 3, feature 9' represents the amount of the reduction of material. The top-most layer is reduced by a certain amount. The lower layers of 9' are longer. Thus, the lower layers have more of their length removed from the preform; the lower layers have a greater reduction in length. And looking at the top layer and the "immediate prior layer" - the one-ended length reduction of the top layer is 'less than a reduction in length of an immediate prior layer'.

This is deemed to be a *prima facie* showing of lack of support required by 35 USC 112, first paragraph. Appellant has failed to show support for this limitation.

(11) Response to Argument

It is argued that Examiner has misconstrued the claims because the claims do not require a cutting step. Examiner agrees that the reduction in length of a layer need not be limited to "cutting". Such was simply a substitute term for the claimed length reduction as shown in figure 3. Examiner apologizes for using the incorrect term. One of ordinary skill would immediately realize that the lengths can be reduced by any conventional means, such as etching, grinding, and ablating. The step of reducing the length is not limited to cutting. Regardless of how the layer is reduced, there is simply no disclosure of the limitation in question.

It is further argued that after the diameter D1 is achieved, there is a one-ended reduction in layer length, followed by the addition of successive layers. This is incorrect. Such is neither claimed or disclosed. All of the layers are applied first (ostensibly while all of the layers' lengths are kept constant) - and then following that, the lengths of the layers are reduced. See figure 2 which shows all of the layers deposited - figure 3 shows the subsequent reduction in length.

It is then stated that in claim 1, that the one-ended reduction in length, is greater than "the previous successive reductions in lengths of the prior layers." This is not understood because all of the layer lengths are reduced simultaneously. The only claimed reductions that are "successive" are the reductions in the displacement lengths - not layer lengths.

It is further argued that Examiner took great pains to construe the claims based on an unreasonable interpretation. Whereas Examiner had difficulty in determining what the scope of claim 1 is - there is no rationale or evidence to support the conclusion that the interpretation is unreasonable. As indicated above, the claims do not require what Appellant states the claims require.

It is further argued that the Office's interpretation is based on since cutting a preform will reduce the length of a layers, that the claims require cutting a preform. As indicated above, Examiner agrees that the claims are not limited to "cutting" - rather they include such things as etching, grinding, compressing---- anything that reduces the length of the layers. Since Applicant's only disclosure of reducing layer lengths is at least very similar to cutting, it is reasonable to rephrase "reducing layer length" to "cutting".

It is then argued that the one ended reduction "...simply refers to the amount of reduction (relative movement of plasma torch and preform)". And that the interposing of the one-ended reduction "requires the addition of a layer that is shortened to create a step-like segment; not the cutting of the layer". It appears that these two statements characterize how Appellant thinks the claims should be interpreted. It appears that

Appellant's position is that the reducing of a length of a layer is not actually reducing the length of the layer - rather, it is simply making a layer that has a shorter length than a previous layer. It is **completely** unreasonable to interpret a "reduction" as something that really is not a reduction. If such were acceptable practice, then inventors would be free to state that "up" really means "down", that "black" means "white", and "cold" means "hot". And when in those rare instances where contradictory terminology is proper - the specification must clearly set out what the definition is to be. The present application does not have any such definitions. One of ordinary skill would interpret a "reduction in length of at least one layer" as the layer having a length, and reducing that length - to a value which is less than its prior value (e.g. from 20 cm to 15 cm). Appellant's position seems to be that the length of layer is reduced prior to it even being made. This would make the claims even more difficult to interpret - because one could argue that any layer is reduced (relative to its non-existent self) - regardless of its actual length. One could arbitrarily decide how long a layer could have been, and then state that the final (actually deposited) length has been reduced compared to yet-to-be (and never will be) created layer. Alternatively, if the reduction is relative to some prior layer, Examiner would have to interpret what the scope of the prior layer is - since the claim does not indicate what that prior layer is. Since the prior art has numerous methods where multiple torches are applying layers (of various lengths) simultaneously, as soon as Examiner picks one layer relative to which the other layer is "reduced" Appellant could again argue that it is an unreasonable interpretation. The Office could never be sure

Art Unit: 1731

what is actually being claimed. The plain meaning of "reducing" a length of a layer, must be interpreted as having a layer with a length, followed by making that length less.

MPEP 2111.01 Plain Meaning

**THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING"
UNLESS THEY ARE DEFINED IN THE SPECIFICATION**

While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be

given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Applicant has not provided any definition for "reduction" "layer" or "length". Thus Their plain meaning must be used. One of ordinary skill need not even consult a dictionary because the terms "reduction", "length" and "layer" are very plain and ordinary and cannot be reasonable construed to be interpreted as Appellant seems to suggest.

Since the specification does not set forth what is meant by "reduction" Examiner had no choice but to use the plain meaning for reduction. To the degree that Appellant deems the plain meaning "unreasonable" - it would be doubly unreasonable for examiner to construct a meaning out of thin air (or even in light of the specifcation) Examiner had no choice but use the plain meaning or construct one himself

Furthermore, the shortening of the displacements are deemed to be required at line 17 of claim 1. To interpret the claims as Appellant suggests, would amount to double inclusion in the making layers of progressively shorter lengths.

Even if one were to accept the argument that making a length less long than a previous layer is a "reduction" in length of the layer, Applicant's reduction occurs at both

Art Unit: 1731

ends - it is clearly not "one-ended." One of ordinary-skill upon reading "one-ended" is immediately notified that such is the shortening showing in figure 3. The position that the shortening on two sides is actually a "one-sided reduction" is unsustainable.

Applicant's interpretation that the two-sided shortening is one-sided is not reasonable in light of the plain meaning of the word and/or in light of the specification.

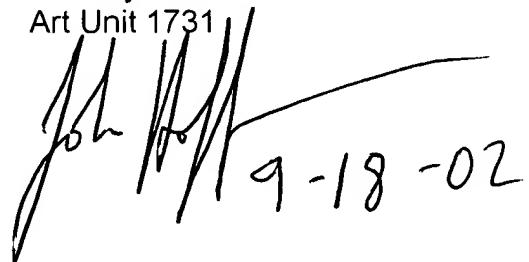
It is also noted that instant claim 3 requires that the diameter above the location where the reduction takes place is greater than the other diameter. This is clearly in reference to the reduction in length that is shown in figure 3. That which Appellant argues is the reduction in length occurs when all of the layers are equal. So claim 3 is even further limited to the reduction shown in figure 3.

The examiner requests the opportunity to present arguments at the oral hearing. For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1731

Respectfully submitted,

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Primary Examiner
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9-18-02

JMH
September 18, 2002

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